

**REMARKS**

Claims 1-40 are currently pending in this application. Claims 1-5, 11, 13, 21, 22, 24, 30, 35, 36, and 40 have been amended while the remaining claims remain unchanged. New claim 41 has been added. No new subject matter is believed to have been added by this amendment.

On pages 2-4 of the Office Action the Examiner rejects various claims based upon informalities as spelled out on these pages. As a result, claims 3, 5, 11, 13, 21, 22, 24, 30, 35, and 40 have been amended to address these informalities.

On pages 4-5 of the Office Action, the Examiner rejects claims 1-9, 12, 14-18, 21-35, and 36-40 under 35 U.S.C. §101 indicating the claimed invention is directed to non-statutory subject matter. The independent claims in each of these groups, in particular claims 1 and 36 have been amended to make clear that the methods associated with these claims utilize a computer. For that reason, each of these methods now recites how each associated process affects, effects, or is effected by technology and claims 1 and 36 are now believed to contain statutory subject matter and, by way of their dependence upon these claims, claims 2-9, 12, 14-18, 21-35, and 37-40 are also believed to contain statutory subject matter.

On pages 6-8 of the Office Action, the Examiner rejects claims 1, 7, 8, 9, 12, 13, 14, 15, 21, 25, 26, 27, and 28 under 35 U.S.C §103(a) as being obvious from the teaching of United States Patent No. 5,832,457 to O'Brien et al. in view of the teaching of the article "IP: NYT Digital Commerce: Is Delivery the Dealbreaker for E-Commerce?" by Galler (the Galler article). The O'Brien patent is directed to a method and apparatus for selective distribution of discount coupons based on prior customer behavior. Such discount coupons are provided immediately after checkout and require the customer to be present in the establishment. In particular, the prior customer behavior referenced in the O'Brien patent is that behavior associated with a single establishment or franchise. As an example, a supermarket may track the purchases of a particular customer during a visit and, in subsequent visits by that customer, provide coupons directed to the particular needs or interests of that customer based on the prior customer behavior at that supermarket. Furthermore, as described in the Abstract, the O'Brien patent is directed to a system for automatically distributing discount coupons or certificates in a retail store conditioned on a pre-selected combination of present and past shopping behavior of a customer whose order is being processed at a check-out stand. The customer is already in the store and is essentially



being rewarded to purchase more or to return to the store based upon data generated while the customer was present and shopping in the store. Moreover, the O'Brien patent is unrelated to the pickup of a pre-ordered product, which in accordance with amended claim 1, is one step in the method for creating marketing opportunities.

Claim 1, as amended, on the other hand, is directed to a method of creating direct marketing opportunities for individuals known in advance to be visiting a specified retail outlet for pick up or return of a product shipped from a seller unrelated by ownership to that specific retail outlet and providing information for target marketing before, during or after visiting the retail outlet. Therefore, the retail outlet has an opportunity to direct market to an individual that normally would not visit their store or to a regular customer they would not otherwise know in advance was intending to visit the store. Furthermore, in accordance with claim 1, the seller is not related to the retail outlet by ownership.

The Galler article describes the activities of PackageNet and in particular suggests the pick up or return of a pre-ordered product which is not discussed in the O'Brien patent. However, the PackageNet system as described in the Galler article merely permits a purchaser to pick up or return a product from any one of a number of different locations. There is neither a teaching nor a suggestion that marketing information may be provided to these outlets and furthermore that such information might be used to directly market to the individual associated with the product. In addition, in the PackageNet system, as described by the Galler article, the individual pays for the privilege of picking up the package in a store, which is opposite of the arrangement found in amended claim 1 of the subject application.

For these reasons, the Applicants do not believe that claim 1, as amended, is obvious in view of these cited references and, therefore, is believed to be patently distinct over the cited references and the other art of record. Additionally, claims 7, 8, 9, 12, 13, 14, 15, 21, 25, 26, 27, and 28, based upon their dependence upon what is believed to be patentably distinct independent claim 1, are themselves believed to be patentably distinct. Furthermore, in rejecting claim 27, the Examiner indicates that the O'Brien patent is directed to target marketing. The O'Brien patent neither teaches nor suggests using information gathered before the individual visited the store to target market and these features are found in claim 27.

On page 8 of the Office Action, the Examiner rejects claim 2 under 35 U.S.C §103(a) as being obvious from the teaching of the O'Brien patent in view of the teaching of

the Galler article and, further in view of official notice. By way of its dependence upon what is believed to be patentably distinct independent claim 1, claim 2 is itself believed to be patentably distinct.

On page 9 of the Office Action, the Examiner rejects claim 3 under 35 U.S.C §103(a) as being obvious from the teaching of the O'Brien patent in view of the teaching of the Galler article and, further in view of official notice. By way of its dependence upon what is believed to be patentably distinct independent claim 1, claim 3 is itself believed to be patentably distinct.

On page 10 of the Office Action, the Examiner rejects claim 4 under 35 U.S.C §103(a) as being obvious from the teaching of the O'Brien patent in view of the teaching of the Galler article and, further in view of official notice. By way of its dependence upon what is believed to be patentably distinct independent claim 1, claim 4 is itself believed to be patentably distinct.

On page 10 of the Office Action, the Examiner rejects claim 5 under 35 U.S.C §103(a) as being obvious from the teaching of the O'Brien patent in view of the teaching of the Galler article and, further in view of official notice. By way of its dependence upon what is believed to be patentably distinct independent claim 1, claim 5 is itself believed to be patentably distinct.

On page 11 of the Office Action, the Examiner rejects claim 6 under 35 U.S.C §103(a) as being obvious from the teaching of the O'Brien patent in view of the teaching of the Galler article and, further in view of official notice. By way of its dependence upon what is believed to be patentably distinct independent claim 1, claim 6 is itself believed to be patentably distinct.

On page 11 of the Office Action, the Examiner rejects claims 10 and 11 under 35 U.S.C §103(a) as being obvious from the teaching of the O'Brien patent in view of the teaching of the Galler article and, further in view of official notice. By way of their dependence upon what is believed to be patentably distinct independent claim 1, claim 10 and 11 are themselves believed to be patentably distinct.

On page 12 of the Office Action, the Examiner rejects claim 16 under 35 U.S.C §103(a) as being obvious from the teaching of the O'Brien patent in view of the teaching of the Galler article and, further in view of official notice. By way of its dependence

upon what is believed to be patentably distinct independent claim 1, claim 16 is itself believed to be patentably distinct.

On page 13 of the Office Action, the Examiner rejects claims 17 and 18 under 35 U.S.C §103(a) as being obvious from the teaching of the O'Brien patent in view of the teaching of the Galler article and, further in view of official notice. By way of their dependence upon what is believed to be patentably distinct independent claim 1, claims 17 and 18 are themselves believed to be patentably distinct.

On page 13 of the Office Action, the Examiner rejects claims 19 and 20 under 35 U.S.C §103(a) as being obvious from the teaching of the O'Brien patent in view of the teaching of the Galler article and, further in view of official notice. By way of their dependence upon what is believed to be patentably distinct independent claim 1, claims 19 and 20 are themselves believed to be patentably distinct.

On pages 14-15 of the Office Action, the Examiner rejects claim 22, 23, and 24 under 35 U.S.C §103(a) as being obvious from the teaching of the O'Brien patent in view of the teaching of the Galler article and, further in view of official notice. By way of their dependence upon what is believed to be patentably distinct independent claim 1, claims 22, 23, and 24 are themselves believed to be patentably distinct.

On pages 15-16 of the Office Action, the Examiner rejects claim 29, 30, and 33 under 35 U.S.C §103(a) as being obvious from the teaching of the O'Brien patent in view of the teaching of the Galler article and, further in view of official notice. By way of their dependence upon what is believed to be patentably distinct independent claim 1, claims 29, 30, and 32 are themselves believed to be patentably distinct.

On pages 16-17 of the Office Action the Examiner rejects claims 34 and 35 under 35 U.S.C §103(a) as being obvious from the teaching of the O'Brien patent in view of the teaching of the Galler article and of official notice and furthermore in view of the articles of the PackageNet web site. Claim 34 and 35 depend from what is believed to be patentably distinct independent claim 1 and therefore, are themselves believed to be patentably distinct.

On pages 17-18 of the Office Action, the Examiner rejects claims 36, 37, and 40 under 35 U.S.C §103(a) as being obvious from the teaching of the anonymous article titled "Babbage's Expands Online", hereinafter the Babbage article in view of official notice. The Babbage article is directed to an e-commerce operation wherein a potential customer alerts a particular retailer that he/she is interested in a certain product, such as a video game. When

the product is in stock, the potential customer is contacted by e-mail or telephone so that he/she may purchase and pickup the product. First of all, these potential customers are just that. They have not purchased product but merely indicated an interest in purchasing such a product. Therefore, they are not known to be visiting a specific retail outlet within a future time period and such marketing may be ineffective if the potential customer does not visit the store and purchase the product. Second of all, the product is not shipped from a seller unrelated by ownership to that particular retail outlet. There is no teaching or suggestion of either of these features in the Babbage article or in view of official notice. Furthermore, the Babbage article does not teach or suggest at all the creation of marketing opportunities or the sending of marketing messages. For these reasons, claim 36, as amended, is believed to be patentably distinct over the teaching of the Babbage article and of official notice and therefore is believed to be patentably distinct over the prior art of record. By way of their dependence upon what is believed to be patentably distinct independent claim 36, dependent claims 37 and 40 are themselves believed to be patentably distinct over the prior art of record.

On pages 18-19 of the Office Action, the Examiner rejects claims 38 and 39 under 35 U.S.C. §103(a) as being obvious from the teaching of the anonymous article titled "Babbage's Expands Online", hereinafter the Babbage article, in view of official notice and further in view of the article titled "Till Death Do You Part..." by Edelstein, hereinafter the Edelstein article. By way of their dependence upon what is believed to be patentably distinct independent claim 36, dependent claims 38 and 39 are themselves believed to be patentably distinct over the prior art of record.

On pages 20 and 21 of the Office Action the Examiner has indicated that claims 31 and 32 would be allowable if rewritten to overcome the rejection under 35 U.S.C. §101 and if rewritten in independent form. The Applicants recognize these allowable claims and reserves the right to add these claims at a later time in the prosecution of this application.

New claim 41 has been added to specify a method of creating target marketing in a fashion having similarities to that of claim 1, however, individuals are identified that are known in advance by an administrator or supplier to be visiting a specific retail outlet for pickup or return of a product. None of the prior art of record is believed to teach or suggest the features of new claim 41 and therefore this claim is believed to be patentably distinct over the prior art of record.

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Reconsideration of claims 1-40 and allowance of claims 1-41 are respectfully requested.

Respectfully submitted,

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